

Application No. 10/682,444 - - - - 3

Remarks

Claims 11-16 are under consideration. Claim 11 is amended to further define the claimed invention.

While the Examiner's Answer rejects claims 11, 14 and 16 on a new ground, and maintains the rejection of claims 11, 15 and 36 (sic; 16), appealed claims 12 and 13 are no longer subject to a rejection. Accordingly, it is assumed that claims 12 and 13 are now deemed allowable.

The new rejection of claims 11, 14 and 16 under 35 U.S.C. 102(b) as anticipated by Hermach (U.S. Patent No. 3,942,782) is untenable, and is hereby traversed.

As recognized by the Examiner, the present claims call for an interfolder that comprises a pair of coacting folding rolls that together produce a stack of interfolded sheets. Interfolders are illustrated by U.S. Patent No. 1,219,239 and U.S. Patent No. 5,088,707, both of record. U.S. Patent No. 3,942,782 to Hermach, on the other hand, does not show an interfolder but a newspaper folding apparatus that does not and cannot produce a stack of interfolded sheets. Hermach's product is shown in FIG. 5 where it can be readily seen that web sections A, B, C, D, E, F are not interfolded but merely stacked one on top of another. Independent claim 11 expressly calls for production of interfolded sheets of material.

Hermach only shows a single folding cylinder (cylinder 36) downstream from folding boards 26A-26C. The present claims call for an interfolder that comprises a pair of folding rolls. A single folding cylinder as shown by Hermach cannot possibly interfold sheets of material.

Cylinder 37 is not a folding cylinder but a cutting cylinder, see col. 4, lines 67-68, for separating individual newspaper sections that then pass through rollers 38 and are individually placed into pockets of delivery fan wheel 39 for deposit on conveyor 40. See col. 5, lines 1-4 and FIG. 2. Rollers 38 do not constitute an interfolder because rollers 38 do not coact to produce an interfolded product. See, for example col. 4, line 64 to col. 5, line 14.

Cross-folding of a collated newspaper does not produce a stack of interfolded sheet material. See FIG. 5. Also, as can be seen in FIG. 2, rollers 38 are spaced from one another.

Application No. 10/682,444 - - - - 4

The Examiner's conjecture that "... broadly considering the claimed 'interfolder' for producing 'interfolded sheets of material' could be nothing more than folding the folded sheets stacked on top of each other to form the claimed 'interfold'" has no basis in fact and most certainly is not taught by Hermach. Even if the folded sheets shown in FIG. 5 were to be further folded cross-wise, interfolded sheets of material would not obtain.

The new anticipation rejection of claims 11, 14 and 16 based on Hermach is not sustainable and should be withdrawn.

The prior rejection of claims 11, 15 and 16 under 35 U.S.C. 103(a) is not warranted and should be withdrawn as well for reasons stated in Appellant's Brief. Paragraphs 7A., 7B., 7E., 7F., 8. and 9. of Appellant's Brief are hereby incorporated by reference.

The deficiencies of the obviousness rejection enumerated in Appellant's Brief have not been obviated. The necessary Graham v. John Deere Co., 383 U.S. 1 (1966), factual inquiries are not of record, thus there is no valid basis for a rejection based on obviousness. Also, as the finding of patent validity in United States v. Adams, 383 U.S. 39 (1966), amply underscores, all evidence must be marshaled before a decision can be made whether a particular invention is obvious or nonobvious. In this case the record is devoid of the necessary findings. The level of ordinary skill in the pertinent art at the time the claimed invention was made remains unresolved as noted before. Objective evidence of unobviousness, the IDEA Achievement Award nomination, has been impermissibly ignored, and stands rebutted. See M.P.E.P. §2141, III. The issue of motivation to combine references cannot be reached and addressed unless the level of ordinary skill in the interfolding art has been established and the nature of the problem to be solved has been identified. The present record shows nothing of the kind. No findings of fact have been presented, only argument.

There is no valid factual basis that Stemmler "discloses the invention as claimed." If indeed that were the case, there would not have been a perceived need for the Examiner to seek out the Hermach reference from non-analogous art with heavy reliance on applicant's own teachings for guidance. Stemmler indicates no need for an upstream modification of webs W1 and W2 prior to interfolding. The Hermach apparatus does not perform interfolding for reasons discussed hereinabove. Other than applicant's own teachings

Application No. 10/682,444 - - - - 5

there is no nexus for one of ordinary skill, whatever that level may be, to combine these features. The rationale for combining references must be based on the state of the art, not on impermissible hindsight.

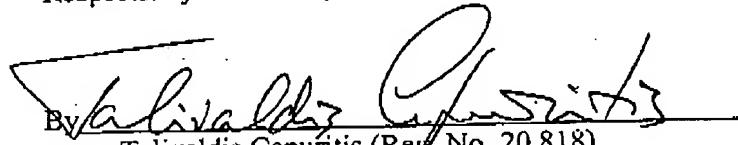
It is only after findings have been made as to (1) the differences between the subject matter sought to be patented and the relevant art, (2) the level of ordinary skill in the relevant field, and (3) the secondary considerations, that a determination of the obviousness of the subject matter as a whole, at the time the invention was made, to one of ordinary skill in the relevant field may be made.

The record in this case fails to make out a *prima facie* case of obviousness. The rejection based on 35 U.S.C. 103(a) should be withdrawn.

Early passing of this application to issue is solicited.

Respectfully submitted,


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